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In re Application of : RIGGS, Glenn E.
Serial No. : 09/915,301 **Examiner:** Susanna M. Meinecke Diaz
Filed : November 17, 2000 **Art Unit:** 3623
Title : TRANSPORT LOGISTICS SYSTEMS AND METHODS

PLEASE FIND ENCLOSED: PETITION FOR PATENT TERM ADJUSTMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**RECEIVED
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Inventors : Glenn E. RIGGS et al.
Application No. : 09/915,301
Filing Date : November 17, 2000
Examiner : Susanna M. Meinecke-Diaz
Art Unit : 3623
Title : TRANSPORT LOGISTICS SYSTEMS AND METHODS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR PATENT TERM ADJUSTMENT

Sir:

Applicants hereby respectfully petition under 37 CFR 1.705(b) for correction of the patent term adjustment, indicated to be 15 days in the Notice of Allowance. Specifically, applicants submit that the patent term extension was erroneously reduced by 100 days and that, without such erroneous reductions, the term extension should have been 115 days. Furthermore, applicants respectfully submit that a further term extension should be granted: 1) pursuant to 35 USC 154(b)(1)(A)(i) for failure to provide a proper and complete Notification under 35 USC 132 within fourteen months of the filing date; 2) pursuant to 35 USC 154(B)(1)(C) due to applicants' successful appeal; and/or 3) pursuant to 35 USC 154(b)(1)(B) for failure to issue the patent within 3 years of the filing date.

In accordance with 37 CFR 1.705(b)(2)(iii) and (iv)(B), applicants state that the above-identified application is not subject to any terminal disclaimer and that there were no circumstances during the prosecution of this application that constituted a failure to engage in reasonable efforts to conclude processing or examination.

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Reasons for Reinstatement of Reduced Patent Term Extension

The patent term extension of 121 days was reduced to 15 days because of 1) mailing delay in filing an office action response (6 days); 2) an Information Disclosure Statement filed after the first Office Action (49 days); and 3) the filing of the Notice of Appeal (51 days). Applicants request reinstatement of part of the reduction in patent term on the grounds that the term extension was improperly reduced: 1) for 49 days because of the Information Disclosure Statement filed after the first Office Action; and 2) for 51 days because of the Notice of Appeal. The reductions should be reinstated such that the term extension is 115 days.

Information Disclosure Statement

The patent term extension was reduced by 49 days because of the Information Disclosure Statement ("IDS") filed after the mailing of the first Office Action. It appears that the reason for the reduction is that the IDS was filed on June 9, 2003, which is 49 days after Applicants submitted their Response to the first Office Action on April 21, 2003.

Applicants recognize that the term extension may be reduced because of Supplemental Responses (see 37 CFR 1.704(c)(8)). However, the IDS was not responsive to the Office Action and was not a Supplemental Response. Applicants also recognize that the term extension may be reduced if the references in a communication from a foreign patent office in a counterpart application are not cited in a IDS within thirty days (see 37 CFR 1.704(d)). However, the references cited in applicants' IDS were discovered independently of, and were not included in, a communication from a foreign patent office in a counterpart.

The three documents listed in the IDS were unknown to applicants at the time of the first Office Action. Applicants duly submitted a certification to this effect pursuant to 37 C.F.R. 1.17(p). Thus, the IDS was properly, and timely, submitted pursuant to 37 C.F.R. 1.97(c), and there was no unjustified delay by applicant. The term extension should not be reduced by 49 days because of applicants' submission of the IDS after the first Office Action.

Notice of Appeal Filing Date

The patent term extension was erroneously reduced by 51 days due to the filing of the Notice of Appeal even though the Notice of Appeal was timely filed. It appears that the reason

for the erroneous reduction is both a failure to recognize the correct due date for filing of the Notice of Appeal and a mistake made in determining the filing date of the Appeal Brief.

The final Office Action was mailed to an incorrect address on July 10, 2003. A shortened statutory period for reply was set for three months from the mailing date, that is, for October 10, 2003. On July 31, 2003, the final Office Action was re-mailed to the correct address. The shortened statutory period was again set for three months from the mailing date, that is, for October 31, 2003.

In response to the final rejection dated July 31, 2003, applicants timely filed a Notice of Appeal to the Board of Patent Appeals and Interferences on October 30, 2003 via facsimile. The Notice of Appeal was resubmitted on December 2, 2003, with a facsimile cover sheet stating "Re-Submission" and along with the Auto-Reply as proof of the earlier submission. The Image File Wrapper in Patent Application Information Retrieval (PAIR) for this application lists the Notice of Appeal twice – once with a date of October 30, 2003 and again with a date of December 2, 2003. Of course, there are not two separate Notices of Appeal – the same Notice of Appeal is saved twice in the Image File Wrapper. The File History in PAIR does not list the Notice of Appeal filed on October 30, 2003. For the date of December 1, 2003, the File History in PAIR does list the Notice of Appeal, and also lists a "Request for Extension of Time – Granted" and a "Amendment/Argument after Notice of Appeal" (although these two documents are not included in the Image File Wrapper). It appears that the Notice of Appeal was mistakenly docketed.

The patent term reduction of 51 days corresponds to the number of days between October 10, 2003 and December 1, 2003. It thus appears that the reduction is based on a miscalculation that the Notice of Appeal was due on October 10, 2003 and was filed on December 1, 2003. The reduction is erroneous because the correct due date for the Notice of Appeal was October 31, 2003, and the Notice of Appeal was timely filed on October 30, 2003.

There should be no reduction to the patent term adjustment. PTO's Patent Term Adjustment History incorrectly states that the notice of appeal was filed on December 1, 2003 and reduced the patent term adjustment by 51 days. Applicants' notice of appeal was timely filed and the patent term adjustment should not be reduced.

Patent Term Extension

Applicants respectfully submit three separate bases for patent term extension. Specifically, applicants submit that a further term extension should be granted: 1) pursuant to 35 USC 154(b)(1)(A)(i) for failure to provide a Notification under 35 USC 132 within fourteen months of the filing date; 2) pursuant to 35 USC 154(b)(1)(C) due to applicants' successful appeal; and/or 3) pursuant to 35 USC 154(b)(1)(B) for failure to issue the patent within 3 years of the filing date. Applicants request that the three bases for patent term extension be considered independently, acknowledging that in the case of overlap, the patent term extension can not exceed the actual number of days of delay pursuant to 35 USC 154(b)(2)(A).

First Notification under Section 132

Applicants respectfully submit that the first Office Action mailed on January 15, 2003 did not provide a proper and complete Notification under 35 USC 132. Although 110 days of patent term extension was calculated depending on the mailing date of the first Office Action, applicants submit that the first Office Action did not comply with 35 USC 132 and that the patent term extension should be measured from the July 31, 2003 corrected mailing date of the second Office Action. Thus, applicants are entitled to an additional 197 days (the number of days from January 15, 2003 to July 31, 2003).

A proper and complete notification under 35 USC 132 includes the reasons for the rejection of claims "together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application..." The first Office Action included an obviousness prior art rejection for many of the claims. The rejection cited a single reference. For several of the features recited in the rejected claims (such as the electronic abstract in claims 26 et seq.), the rejection stated merely that such features were "old and well known in the art..." and did not cite any reference to support such assertion until the second Office Action (see page 22). Indeed, it was not until the Office Communication dated September 23, 2003 that it was explained that the Examiner did not cite the reference in the first Office Action pursuant to the doctrine of Official Notice.

Applicants respectfully submit that the first Office Action was not a proper and complete notification under 35 USC 132. The failure to provide the reference in the first Office Action did not allow applicant to judge the propriety of the rejection. Only when the reference was

provided in the second Office Action could applicants judge the propriety of the rejection. While applicants acknowledge that the Office utilizes a practice based on Official Notice, such practice does not replace, preempt or override the guarantees of patent term provided to applicants by statute. Thus, the corrected mailing date of the second Office Action should be used as the first notification under 35 USC 132 and pursuant to 35 USC 154(b)(1)(A)(i), and applicants should receive an additional patent term extension of 197 days.

Appeal

35 USC 154(b)(1)(C) provides applicants with a guarantee of patent term extension for an appeal to the Board of Patent Appeals and Interferences. Applicants respectfully submit that they are entitled to a patent term extension due to their successful appeal. Applicants therefore request a further patent term extension measured from the filing of the Notice of Appeal on October 30, 2003 up to termination of the appeal. It is not clear if the appeal was properly terminated at any time prior to the Notice of Allowance dated December 13, 2004 (see footnote 1 on page 12 of Applicants' Response filed on November 23, 2004). Thus, applicants request an extension of up to 409 days corresponding to the time period between the Notice of Appeal and the Notice of Allowance. Applicants thus alternatively request a patent term extension for the time period up to the Office Action dated August 23, 2004 (316 days), the time period up to the withdrawn restriction requirement dated March 12, 2004 (122 days), or other appropriate time period. Nevertheless, notwithstanding the uncertainty of the duration under the circumstances described in the following paragraph, it is clear that applicants are not responsible for the delay and some patent term extension is warranted.

Applicants timely noted an Appeal and filed an Appeal Brief. In an Office Communication from the Examiner dated March 12, 2004, applicants' arguments in the Appeal Brief were deemed to be persuasive and the pending prior art rejections were withdrawn. The Examiner subsequently set forth a restriction requirement in the Communication. On April 12, 2004, applicants submitted a Petition arguing that the Restriction Requirement was procedurally improper. In an Office Communication dated August 23, 2004, the Examiner withdrew the restriction requirement and entered new rejections. Since part of the rejections were based on prior art known prior to the appeal, applicants noted in footnote 1 of their Response filed on November 23, 2004 that they would not agree to termination of the appeal.

Three Year Pendency

35 USC 154(b)(1)(B) provides applicants with a guarantee of patent term extension for failure of the Office to issue the patent within 3 years of the filing date. This application was filed on July 27, 2001. Except for six (6) days due to applicants' mailing delays, applicants are entitled to a patent term extension for the time period from July 27, 2004 until the date on which the patent is granted. The exact number of days of patent term extension is impossible to state at this time since it is not currently known when the patent will be granted. Furthermore, since applicants are entitled to patent term extension due to other bases which may overlap, the exact number of days of patent term extension due to 35 USC 154(b)(1)(B) can not be determined at this time.

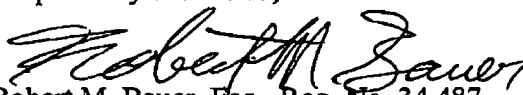
Thus, in accordance with 37 C.F.R. 1.703 and 1.704, applicants request further patent term adjustments of 197 days for the first notification under 35 USC 132 and up to 409 days for the appeal, as well as a term extension of yet undeterminable period for the pendency in excess of three years. Applicants do not request duplicative patent term extensions for any overlap in the requested patent term extensions.

Fee Authorization

In accordance with 37 C.F.R. 1.18(e), a fee of \$200 is required. The Commissioner is hereby authorized to charge such fee, and any other fees necessary for the consideration of this Petition or allowance of this application, to Deposit Account No. 02-4270.

Dated: February 28, 2005

Respectfully submitted,


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